

REMARKS

In the April 5, 2004 Office Action, claims 1-8 and 11-13 and 16-19 stand rejected in view of prior art, while claims 9, 10 and 15 are allowed and claims 20 and 21 are indicated as containing allowable subject matter. No other objections or rejections were made in the Office Action.

Status of Claims and Amendments

In response to the April 5, 2004 Office Action, Applicant has amended claims 1, 2 and 20, and added new claim 22, as indicated above. Thus, claims 1-13 and 15-22 are pending, with claims 1, 2, 9, 20 and 22 being the only independent claims. Reexamination and reconsideration of the pending claims are respectfully requested in view of the above amendments and the following comments.

Rejections - 35 U.S.C. §103

In the numbered paragraphs 1 and 2 of the Office Action, claims 1-8 and 11-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,099,425 (Kondo) in view of U.S. Patent No. 3,730,012 (Juy). In response, Applicant respectfully traverses this rejection, especially in view of the amendments to independent claims 1 and 2, as explained below.

Applicant notes that claims 20 and 21 appear to have been inadvertently included in the 35 U.S.C. §103(a) rejection since claims 20 and 21 were indicated as containing allowable subject matter in paragraph 4 of the Office Action, and were indicated only as being objected to in the Office Action Summary. Similarly, claim 15 appears to have been inadvertently included in the 35 U.S.C. §103(a) rejection since this claim was indicated as being allowed in paragraph 3 of the Office Action and the Office Action Summary.

Independent claim 1, as now amended, requires a front derailleur with the mounting portion of the fixed member being configured and arranged relative to the first and second mounting flanges to define a transverse center plane that is perpendicular to the second pivot axis and passes between the first and second mounting flanges and through the center axis of the curved mounting surface with the first mounting flange being located on a first side of the center plane and the second mounting flange being located on a second side of the center

plane that is opposite to the first side of the plane, the center plane being equally spaced and parallel to a transverse front plane passing through a forward most edge of the curved mounting surface and a transverse rear plane passing through a rearward most edge of the curved mounting surface, the front and rear planes defining a mounting area therebetween, the first and second mounting flanges having different axial widths as measured along the second pivot axis with the wider of the first and second mounting flanges being arranged such that a majority of its axial width is located outside the mounting area in an axial direction, the first and second mounting flanges having first and second rear surfaces that are spaced apart by an axial distance larger than an axial space between the front and rear planes. Applicant does not believe that this unique arrangement is disclosed or suggested by the Kondo patent and/or Juy patent, as suggested in the Office Action.

Independent claim 2, as now amended, requires a fixed member having a mounting portion configured to be coupled to a frame portion of the bicycle, the fixed member including a first mounting flange with a first rearward surface and a second mounting flange with a second rearward surface axially spaced from the first mounting flange; a chain guide having a chain receiving slot to shift a chain of the bicycle in a transverse direction, a first support flange extending laterally therefrom and a second support flange extending laterally therefrom that is axially spaced from the first support flange; and a linkage assembly coupled between the chain guide and the fixed member, the first link being pivotally coupled to one of the first and second support flanges, and the second link pivotally coupled to the first and second mounting flanges for rotation about a second pivot axis passing through the first and second mounting flanges that is substantially parallel to the first pivot axis, and being pivotally coupled to said first and second support flanges, the first and second mounting flanges having different axial widths as measured along the second pivot axis and being arranged such that the first and second rearward surfaces are spaced apart by a first axial distance that is about one half of a maximum axial length of the chain guide, the second link being supported by the first and second mounting flanges at locations spaced at least as wide as said first axial distance, the first and second support flanges of the chain guide being spaced apart by a second axial distance that is substantially equal to the first axial distance. Applicant does not believe that this unique arrangement is disclosed or suggested by the Kondo patent and/or Juy patent, as suggested in the Office Action.

In particular, Applicant does not believe one of ordinary skill in the art would combine features of the Juy patent with the Kondo patent to result in the claimed invention of independent claim 1 or independent claim 2, especially as now amended. Specifically, Applicant believes there is no motivation to make such a hypothetical combination as asserted in the Office Action. Moreover, Applicant believes that even if one of ordinary skill in the art did combine the teachings of the Juy patent with the Kondo patent, a hypothetical device created by such a combination would not include all of the features of independent claim 1 and/or independent claim 2, especially as now amended.

The Office Action basically indicates that the Kondo patent discloses a front derailleur for a bicycle in figure 4 as required by the claims, except first and second mounting flanges having different axial widths as measured along the second pivot axis. However, the Office Action indicates that the Juy patent teaches in figure 2 a front derailleur comprising, *inter alia*, a first mounting flange and a second mounting flange having different axial widths. Thus, the Office Action indicates that it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of the Kondo patent to provide said first and second mounting flanges with different axial widths, in view of the teachings of the Juy patent, so as to increase strength of one of the flanges relative to the other of the flanges. Applicant respectfully disagrees with the position of the Office Action, especially in view of the amendments to claims 1 and 2, as explained below.

With respect to claims 3-8, 11-13 and 16, the Office Action indicates that the reference combination previously set forth does not disclose the specific dimensional relationships as claimed of the elements. However, the Office Action states that the actual dimension is merely a matter of engineering design choice and the level of skill of one of ordinary skill in the art would produce a similar optimization, especially lacking any evidence to the contrary, i.e., unexpected results. Furthermore, the Office Action states that it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 10 USPQ 233 (CCPA 1955). Applicant respectfully disagrees with these positions of the Office Action and the approach to examining the claims directed to dimensional relationships in this case. Regardless of whether a limitation is dimensional or otherwise, it is well settled in U.S. patent law that the mere fact that the prior art can be modified does **not** make the modification obvious, unless the prior art **suggests** the desirability of the modification.

Detailed Arguments

First, Applicant believes there is no motivation to selectively modify the derailleur of the Kondo patent in view of the Juy patent, as asserted in the Office Action. The derailleurs of Kondo and Juy operate in fundamentally different, unique ways that are not interchangeable. Thus, somehow combining teachings of the Juy patent with the Kondo patent requires a complete reconstruction of the device of the Kondo patent, ignoring that advantages of the current Kondo device and destroying it for its intended purpose. Moreover, such a hypothetical device arguably would not even work. Rather, it appears that hindsight from Applicant's disclosure has been used in an attempt to reconstruct the claimed invention from isolated features of these two references.

Second, even if the teachings of the Juy patent were somehow combined with the Kondo patent, such a hypothetical device would not result in the unique arrangement of the wider of the first and second mounting flanges being arranged such that a majority of its axial width is located outside the mounting area in an axial direction, the first and second mounting flanges having first and second rear surfaces that are spaced apart by an axial distance larger than an axial space between the front and rear planes, as required by independent claim 1. In other words, in the Juy patent, the mounting flanges are arranged in a compact area with the wider flange completely overlapping the mounting area between front and rear planes and with the rearwardmost surfaces of the flanges being relatively close together. Thus, at best, if the teachings of the Juy patent were combined with the Kondo patent, the mounting flanges would be made wider in direction(s) toward the center transverse plane so as fit within a compact area. Accordingly, withdrawal of the rejection is respectfully requested.

Moreover, even if the teachings of the Juy patent were somehow combined with the Kondo patent, such a hypothetical device would not result in the unique arrangement of the first and second mounting flanges having different axial widths as measured along the second pivot axis and being arranged such that the first and second rearward surfaces are spaced apart by a first axial distance that is about one half of a maximum axial length of the chain guide, the second link being supported by the first and second mounting flanges at locations spaced at least as wide as the first axial distance, and the first and second support flanges of the chain guide being spaced apart by a second axial distance that is substantially equal to the

first axial distance, as required by independent claim 2. In particular, in both of these references, the mounting flanges are arranged in a relatively compact area relative to the overall axial length of the chain guide to support the chain guide in a relatively narrow area relative to its overall axial length. Accordingly, withdrawal of the rejection is respectfully requested.

Moreover, Applicant believes that the dependent claims 3-8, 11-13 and 16-19 are also allowable over the prior art of record in that they depend from independent claim 1 or 2, respectively, and therefore are allowable for the reasons stated above. Also, the dependent claims are further allowable because they include additional limitations. Therefore, Applicant respectfully requests that this rejection be withdrawn in view of the above comments and amendments.

New Claim

Applicant has added new independent claim 22. New claim 22 requires, *inter alia*, a chain guide having a forward most free edge, and a rearward most free edge with a longitudinal center point equally space from the free edges, the rear mounting flange of the chain guide that is pivotally coupled to the first and second links being located at least partially rearwardly of the longitudinal center point of the chain guide. Applicant believes that none of the prior art discloses or suggests the unique arrangement of claim 22.

Allowable Subject Matter

In the numbered paragraph 3 and 4 of the Office Action, claims 9, 10 and 15 were indicated as allowed, and claims 20 and 21 were indicated as containing allowable subject matter. Applicant wishes to thank the Examiner for this indication of allowable subject matter and the thorough examination of this application. In response, Applicant has amended claim 20 to place this claim in independent form. Thus, Applicant believes claims 9, 10, 15 and 21 are in condition for allowance.

Response to Arguments

In paragraph 5 of the Office Action, the Office Action indicates that Applicant's arguments with respect to claims 1-8, 11-13 and 16-19 have been considered but are moot in view of the new ground(s) of rejection. The Office Action further indicates that although the

Juy patent does not disclose the positioning of the first mounting flange and the second mounting flange relative to a plane perpendicular to the second pivot axis and passing through the center of the mounting portion, the Kondo patent discloses such an arrangement. Similarly, the Office Action indicates that the Kondo patent also discloses the first pivot axis substantially coincident with a center plane of the frame that extends substantially parallel to the first pivot axis. Applicant respectfully disagrees with the position of the Office Action.

In particular, as mentioned above, it appears that the Office Action is attempting to selectively combine isolated features from the Kondo patent and the Juy patent in an attempt to reconstruct the claimed invention based on hindsight gleaned from Applicant's disclosure. Moreover, as mentioned above, Applicant believes the devices of the Kondo patent and the Juy patent operate in fundamentally different, unique ways that are not interchangeable. Thus, one of ordinary skill in the art would not selectively attempt to combine isolated features from these references while ignoring other features.

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In view of the foregoing amendment and comments, Applicant respectfully asserts that claims 1-13 and 15-21 are now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested. If you have any questions regarding this Amendment, please feel free to contact the undersigned.

Respectfully submitted,



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